



PATENT
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Roland BAZIN et al.) Group Art Unit: 3771
)
Application No.: 09/725,048) Examiner: Annette F. Dixon
)
Filed: November 29, 2000) Confirmation No.: 8605
)
For: PROCESS FOR ACQUIRING)
SCANNED IMAGE DATA)
RELATING TO AN EXTERNAL)
BODY PORTION AND/OR A)
PRODUCT APPLIED THERETO)

Mail Stop Appeal Brief

Commissioner for Patents
P.O. Box 1450
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Sir:

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the final Office Action dated December 23, 2008 ("final Office Action"), rejecting claims in association with the above-referenced patent application. In accordance with M.P.E.P. § 1204.1, prior Appeal Brief fee payments of \$500.00 filed on June 20, 2005, and \$10.00 filed on February 5, 2008, should be applied to the Appeal Brief fee payment for this Appeal Brief.

A Notice of Appeal was filed on March 23, 2009, and this Appeal Brief is timely filed under 37 C.F.R. § 41.31.

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I. Real Party in Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office ("USPTO") at Real 011677, Frame 0567, on April 6, 2001.

II. Related Appeals and Interferences

In U.S. Application No. 09/725,049 (attorney docket No. 05725.0784-00000), which is now abandoned, an Appeal Brief was filed on August 15, 2005, and the Examiner subsequently re-opened prosecution prior to any decision by the Board. The Appeal Brief filed in U.S. Application No. 09/725,049 may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, and a copy of that Appeal Brief has been submitted herewith.

Appellants, Appellants' legal representatives, and assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-3, 21-23, 49-58, 60, and 63 have been previously canceled without prejudice or disclaimer. Claims 4-20, 24-48, 59, 61 and 62 are pending in this application, of which claims 5, 9, 10, 12-20, and 24 have been withdrawn from consideration. Claims 4, 6-8, 11, 25-48, 59, 61, and 62,¹ as set forth in the Claims Appendix, have been rejected in the final Office Action dated December 23, 2008, and the rejections applied to those claims are at issue in this appeal.

¹ In separate claim rejections under 35 U.S.C. § 112, first paragraph, and § 112, second paragraph, the Examiner listed claim 60 as being rejected. Appellants respectfully note that claim 60 is no longer present in the application. Thus, Appellants have not listed the status of claim 60 as being rejected and have not listed claim 60 in the comments outlining why the claim rejections under §112, first and second paragraphs, are improper and should be reversed.

IV. Status of Amendments

No amendments under 37 C.F.R. § 1.116 have been filed subsequent or in response to the final Office Action of December 23, 2008.

V. Summary of Claimed Subject Matter

A. Independent Claim 4

The subject matter set forth in independent claim 4 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. (P. 4, ll. 3-5.)² The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. (P. 4, ll. 7-9; Figs. 5-7.) In the process of claim 4, the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto, and the image of the scanned image data is representative of at least one characteristic of the cosmetic product. (P. 5, l. 10 - p. 6, l. 4; p. 17, l. 19 - p. 18, l. 19; Fig. 7.)

² The references to the specification and drawings in this Appeal Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary embodiments and exemplary disclosure relating to the claimed subject matter. Those references should not be construed as limiting the claims.

B. Independent Claim 11

The subject matter set forth in independent claim 11 relates to a process for acquiring scanned image data relating to an external body portion and/or product applied to the external body portion. (P. 4, ll. 3-5.) The process comprises placing a transfer member in contact with an external portion of an individual as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. (P. 4, ll. 7-9; Figs. 5-7.) In the process of claim 11, the transfer member is moldable material, and the process includes placing the moldable material in direct contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin. (P. 6, ll. 5-7; p. 18, l. 20 - p. 19, l. 2.)

C. Independent Claim 25

The subject matter set forth in claim 25 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. (P. 4, ll. 3-5.) The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on

the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. (P. 4, ll. 7-9; Figs. 5-7.) In the process of claim 25, the image scanner is associated with a first computer located at a first location, and the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location. (P. 7, ll. 8-13; Fig. 1.) In addition, the image scanner is configured in the form of a scanner for scanning documents. (P. 14, ll. 19-21; Fig. 5.)

D. Independent Claim 37

The subject matter set forth in claim 37 relates to a process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion. (P. 7, ll. 18-19.) The process comprises acquiring scanned image data. The acquiring process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member (p. 4, ll. 5-6; Figs. 3, 4, and 7), wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another (p. 5, ll. 1-14; Fig. 4), and wherein the transfer image is not a fingerprint or fingerprints, and the external portion that the

transfer member is placed in contact with does not include a tooth or teeth (p. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7); and scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion (p. 4, ll. 7-9; Figs. 5-7). The process of claim 37 further includes displaying an image corresponding to the scanned image data, viewing the displayed image to analyze the at least one characteristic, and comparing the displayed image to at least one image formed from image data stored in an image database. (P. 7, ll. 19-21; p. 10, ll. 4-6.)

E. Independent Claim 38

The subject matter set forth in claim 38 relates to a process for recommending treatment for an external body portion. (P. 9, ll. 6-7.) The process comprises analyzing at least one characteristic of an external body portion, wherein the analyzing comprises acquiring scanned image data, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze the at least one characteristic. (P. 7, ll. 19-21.) The acquiring comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member (p. 4, ll. 5-6; Figs. 3, 4, and 7), wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another (p. 5, ll. 1-14; Fig. 4), and wherein the transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth (p. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7); and scanning the transfer image with an optical image scanner to obtain scanned image

data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion (p. 4, ll. 7-9; Figs. 5-7). The process of claim 38 further comprises determining a recommendation of at least one treatment for the external portion, and providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation. (P. 9, ll. 6-19.) In addition, claim 38 recites that the image scanner is configured in the form of a scanner for scanning documents. (P. 14, ll. 19-21.)

F. Independent Claim 46

The subject matter set forth in claim 46 relates to a process of evaluating a product applied to an external body portion. (P. 9, ll. 20-22.) The process comprises analyzing at least one characteristic of a product applied to an external body portion. (P. 8, ll. 11-19.) The analyzing step comprises acquiring scanned image data, displaying an image corresponding to the scanned image data, and viewing the displayed image to analyze at least one characteristic. (P. 7, ll. 18-21.) Acquiring scanned image data comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) Acquiring scanned image data further comprises scanning the transfer image with an optical image scanner to obtain

scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion.

(P. 4, ll. 7-9; Figs. 5-7.)

G. Independent Claim 48

The subject matter set forth in claim 48 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. (P. 4, ll. 3-5.) The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. (P. 4, ll. 7-9; Figs. 5-7.) As set forth in claim 48, the process further comprises collecting information relating to the transfer image of the transfer member to form a database for use in at least one of the following: diagnoses, treatment recommendation determinations, product evaluations, and product formulations. (P. 10, ll. 1-4.)

H. Independent Claim 59

The subject matter set forth in claim 59 relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion. (P. 4, ll. 3-5.) The process comprises placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member. (P. 4, ll. 5-6; Figs. 3, 4, and 7.) The transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another. (P. 5, ll. 1-14; Fig. 4.) The transfer image is not a fingerprint or fingerprints, and the external portion that the transfer member is placed in contact with does not include a tooth or teeth. (P. 4, ll. 10-17; p. 8, ll. 1-10; Figs. 3, 4, and 7.) The process further comprises scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion. (P. 4, ll. 7-9; Figs. 5-7.) As set forth in claim 59, the process further comprises analyzing the external body portion and/or the transfer member with analysis equipment chosen from one of a corneometer, a dermal torque meter, a pH meter, and a device for measuring hydration of the skin. (P. 25, ll. 5-9.)

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 4, 6, 7, 11, 25-48, 59, 61, and 62 stand rejected under 35 U.S.C. §112, first paragraph. Final Office Action at 2.

Claims 4, 6, 7, 11, 25-48, 59, 61, and 62 stand rejected under 35 U.S.C. §112, second paragraph. Id. at 3.

Claims 4, 6, 61, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 5,343,536 to Groh ("Groh"). Id. at 5.

Claims 4, 7, 8, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,533,971 to Stess et al. ("Stess"). Id. at 13.

Claims 25-36 and 38-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of Kvedar et al., "Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development" ("Kvedar") and U.S. Patent No. 6,801,343 to Sheng ("Sheng"). Id. at 9.

Claims 37, 46, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of Kvedar. Id. at 6.

Claim 48 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of Sheng. Id. at 9.

Claim 59 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Groh in view of Kvedar and U.S. Patent No. 6,296,880 to Murad ("Murad"). Id. at 8.

VII. Argument

Summary of Argument

The rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. §112, first paragraph, should be reversed because a person skilled in the art would clearly understand that Appellants were in possession of the subject matter recited in the amendments to independent claims 4, 11, 25, 37, 38, 46, 48, and 59, as of the filing date of the application.

The rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, second paragraph, should be reversed because claims covering more than one disclosed embodiment are not necessarily improper under § 112, second paragraph.

The rejection of claims 4, 6, 61, and 62 under 35 U.S.C. §103(a) based on Groh should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, Groh teaches away from the Examiner's proposed, hypothetical modification to Groh's disclosed device, and further, there is no reasonable expectation that the hypothetical modification would be successful.

The rejection of claims 4, 7, 8, and 11 under 35 U.S.C. §103(a) based on Stess should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, Stess fails to disclose or render obvious all of the subject matter recited in independent claims 4 and 11, and the Examiner has failed to articulate any rationale in purported support concerning why the differences between Stess and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art.

The rejection of claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

The rejection of claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, Groh and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claims 37 and 46, and the Examiner has failed to articulate any rationale to support her contention that the differences between those references and the subject matter recited would have been obvious to a person having ordinary skill in the art.

The rejection of claim 48 under 35 U.S.C. § 103(a) based on Groh in combination with Sheng should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

The rejection of claim 59 under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Murad should be reversed because the Examiner has failed to set forth a *prima facie* case of obviousness. In particular, the Examiner's proposed, hypothetical modification to Groh's device is contrary to its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful.

A. Rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. §112, first paragraph, should be reversed because a person skilled in the art would clearly understand that Appellants were in possession of the subject matter recited in the amendment to independent claims 4, 11, 25, 37, 38, 46, 48, and 59 as of the filing date of the application

In the final Office Action, the Examiner rejected claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, first paragraph, because subject matter included in the amendments to claims 4, 11, 25, 37, 38, 46, 48, and 59 included in the Amendment filed April 28, 2004, is allegedly not supported by the originally-filed application. Final Office Action at 2. In particular, the Examiner alleges that “the originally filed disclosure does not provide evidence that Applicant possessed [the claim limitations ‘not a fingerprint or fingerprints’ and ‘does not include a tooth or teeth’] at the time the application was filed.” Id. Appellants respectfully submit that this rejection is improper and should be reversed at least because the originally-filed application clearly supports the subject matter included in the amendments to claims 4, 11, 25, 37, 38, 46, 48, and 59.

Appellants respectfully submit that the recitations in, for example, claim 4, that a “transfer image is not a fingerprint or fingerprints,” and that an “external portion that [a] transfer member is placed in contact with does not include a tooth or teeth” are supported by the originally-filed application in accordance with 35 U.S.C. § 112, first paragraph. According to The Manual of Patent Examining Procedure (8th ed. rev. 7 July 2008) (“M.P.E.P.”), “[a]ny negative limitation or exclusionary proviso must have basis in the original disclosure[, but i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” § 2173.05(i) (citation omitted).

Appellants respectfully submit that “fingerprints” and “teeth” are positively recited in the originally-filed application, and thus, the negative recitation relating to those elements is proper under 35 U.S.C. § 112, first paragraph, and is in compliance with the M.P.E.P. For example, at page 4, line 13, of the originally-filed application, the description positively recites “teeth.” Moreover, teeth and nondermatoglyphic features, which include the *lack* of a fingerprint and/or fingerprints, are recited at page 8, lines 1-10, of the originally-filed description. (Appellants also respectfully note that in a Reply to Office Action filed December 5, 2005, Appellants traversed a claim rejection under 35 U.S.C. § 112, first paragraph, that relied on a flawed rationale at least similar to the flawed rationale included in the present final Office Action, and the Examiner withdrew the claim rejection in the next Office Action.)

In the “Response to Arguments” section of the final Office Action, the Examiner alleges that reciting “wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth,” and reciting “the transfer image is not a fingerprint or fingerprints” is “clearly contradictory” to the originally-filed specification. Final Office Action at 16. Appellants respectfully submit that the originally-filed specification discloses exemplary alternative embodiments where “[t]he external portion could be on many different areas of the body of the individual[, f]or example, the external body portion could include . . . at least one tooth” (Page 4, lines 10-13 (emphasis added)). Further, the originally-filed specification discloses that the transfer image may include “fingerprints.” (Page 8, lines 1-6). There is no disclosure in the originally-filed specification that requires that the external portion must include “at least one tooth” or that the transfer image must include “fingerprints.” Thus, contrary to the

Examiner's allegations, the subject matter recited in the claims is not "clearly contradictory" to the originally-filed specification. Rather, the claims merely exclude one or more of the exemplary alternative embodiments disclosed in the originally-filed application. Neither the M.P.E.P. nor 35 U.S.C. § 112, first paragraph, prohibits such a practice. See, e.g., § 2173.05(i) (advising that "[a]ny negative limitation or exclusionary proviso must have basis in the original disclosure[, but i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.") Thus, the subject matter recited in the claim amendments is fully-supported by the originally-filed application.

For at least these reasons, the originally-filed application supports the negative limitations relating to fingerprint(s) and teeth added to the claims in the Amendment filed April 28, 2004. Therefore, Appellants respectfully request that the Board reverse the improper rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, first paragraph.

B. Rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, second paragraph, should be reversed because claims covering more than one disclosed embodiment are not necessarily improper under § 112, second paragraph

The Examiner rejected claims 4, 6, 7, 11, 25-48, 59, 61 and 62 under 35 U.S.C. § 112, second paragraph. Final Office Action at 3. The Examiner alleges that claims 4, 6, 7, 11, 25-48, 59, 61, and 62 are purportedly "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Id. In particular, the Examiner alleges that "Applicant appears to be claiming multiple embodiments with in [sic] one claim," and requests that "Applicant carefully review each

of the claims to ensure that only one disclosed embodiment is recited.” Id. at 3-4. The Examiner apparently believes that independent claim 4 is indefinite because “[c]laim 4 recites a transfer member wherein the transfer member is applied to an external body portion and then later recites a transfer member (assumed to be same transfer member) is applied to an external body portion having a cosmetic product applied thereto.” Id. at 3-4.

Appellants respectfully submit that (1) it is not necessarily improper under 35 U.S.C. § 112, second paragraph, for a claim to encompass more than one embodiment, and (2) the scope and meaning of independent claim 4 would be clear to a person having ordinary skill in the art. Concerning claim breadth, according to the M.P.E.P. “[b]readth of a claim is not to be equated with indefiniteness.” § 2173.04 (citing In re Miller, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971)). Indeed, an example of a claim that encompasses the subject matter of more than one disclosed embodiment is commonly referred to as a “generic claim.” See, e.g., M.P.E.P. § 806.04(d) (providing a definition of “generic claim”). Thus, simply because a claim is broad enough to cover more than one embodiment, does not necessarily result in that claim being improper under 35 U.S.C. § 112, second paragraph, as apparently alleged by the Examiner.

Concerning the Examiner’s uncertainty regarding the recitation in claim 4 of “placing a transfer member in contact with an external portion of an individual,” and “wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto,” Appellants respectfully submit that there is nothing indefinite about this combination of recitations. The first recitation merely sets forth placing a transfer member in contact with an external portion of an individual, and

the second recitation merely further defines the nature of the external body portion with which the transfer member is being placed in contact (i.e., “an external body portion including a cosmetic product applied thereto”). Thus, Appellants respectfully submit that a person having ordinary skill in the art would understand the scope and meaning of claim 4. To the extent that these comments apply to claims 6, 7, 11, 25-48, 59, 61, and 62, a person having ordinary skill in the art would understand the scope and meaning those claims for at least the same reasons.

In the “Response to Arguments” section of the final Office Action, the Examiner alleges that because “there is no direct recitation as [to] [sic] when and where within the recited steps . . . the application of the product occur[s],” the claims rejected under 35 U.S.C. § 112, second paragraph, are indefinite. Final Office Action at 15. Appellants respectfully submit that the Examiner appears to be improperly equating claim breadth with indefiniteness. As outlined above, the M.P.E.P. advises that “[b]readth of a claim is not to be equated with indefiniteness.” § 2173.04 (citing In re Miller, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971)). Therefore, Appellant respectfully submits that the § 112, second paragraph, rejection is improper, regardless of whether there is a “step linking the processes” of “placing the transfer member in contact with the skin and scanning the transfer image” recited in the claims rejected under § 112, second paragraph.

For at least the above-outlined reasons, the rejection of claims 4, 6, 7, 11, 25-48, 59, 61, and 62 under 35 U.S.C. § 112, second paragraph, is improper. Therefore, Appellants respectfully request that the Board reverse the improper claim rejection under 35 U.S.C. § 112, second paragraph.

C. Rejection of claims 4, 6, 61, and 62 under 35 U.S.C. § 103(a) based on Groh should be reversed because independent claim 4 is not *prima facie* obvious based on Groh

- 1. Groh teaches away from the Examiner's proposed, hypothetical modification, and further, there is no reasonable expectation of success if the hypothetical modification were to be made**

The Examiner rejected claims 4, 6, 61, and 62 under 35 U.S.C. § 103(a) based on Groh. Final Office Action at 5. Of the claims rejected, claim 4 is the only independent claim, and Appellants request reversal of the § 103(a) rejection of independent claim 4 because the Examiner fails to establish that independent claim 4 is *prima facie* obvious. Indeed, the Examiner's proposed, hypothetical modification to the device disclosed in Groh would result in changing its principle of operation, and further, there would be no reasonable expectation of success if the Groh device were to be modified in the hypothetical manner proposed by the Examiner.

Under 35 U.S.C. § 103(a), several basic factual inquiries must be made in order to evaluate whether a patent claim is obvious. According to the M.P.E.P., obviousness is a question of law based on these factual inquiries. § 2141(*II*) (citing KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and relying on the framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). In particular, the Graham factual inquiries create a four-part framework for evaluating whether a patent claim is obvious. Graham, 383 U.S. at 17. Those factual inquiries are as follows:

- (A) Determine the scope and contents of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;

(C) Resolve the level of ordinary skill in the pertinent art; and

(D) Evaluate evidence of secondary considerations.

Id. The M.P.E.P. advises that the question of obviousness must be resolved on the basis of these factual determinations. M.P.E.P. § 2141(II).

The M.P.E.P. also provides guidelines for making these factual determinations. For example, the M.P.E.P. cautions that in order to avoid impermissible hindsight reasoning, these factual determinations must be made with respect to “the time the invention was made.” § 2141.01(III). Moreover, the M.P.E.P. cautions that when “determining the differences between the prior art and the claims, the question [of obviousness] is not whether the differences themselves would have been obvious, but [rather, it is] whether the claimed invention as a whole would have been obvious.” § 2141.02(I). Indeed, when considering the prior art, “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” § 2143.03(VI) (second emphasis added).

Once the Graham factual inquiries have been resolved, it must be determined whether a claim is *prima facie* obvious. § 2141(III). Following the guidance of the above-outlined framework, the M.P.E.P. cautions that in order to establish a *prima facie* case of obviousness, “the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” § 2142. Further, “the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person,” but “[k]nowledge of applicant’s disclosure must be put aside in reaching this determination” because “impermissible hindsight must be avoided and a

legal conclusion must be reached on the basis of the facts gleaned from the prior art”; not on the basis of applicant’s disclosure. Id.

Based on this guidance, the M.P.E.P. advises that “[i]f a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” § 2143.01(VI). In other words, if the prior art teaches away from a proposed modification, then the prior art does not render a claim *prima facie* obvious. Further, if there is no reasonable expectation of the success of the proposed modification, then the prior art does not render a claim *prima facie* obvious. § 2143.02(I) (citations omitted).

Turning to the § 103(a) claim rejection based on Groh, Groh fails to disclose or render obvious at least a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process including, *inter alia*, “placing a transfer member in contact with an external portion of an individual . . . , wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4. The Examiner acknowledges this deficiency in Groh, conceding that Groh does not disclose “the application of the transfer member in contact with a cosmetic product applied to an external body portion.” Final Office Action at 6. The Examiner alleges in a completely unsupported manner, however, that “it would have been obvious . . . to modify the device of Groh to capture facial cosmetics worn by the patient,” allegedly because “Groh is used to detect comedones, which often appear on the face,” and “[s]ince application of cosmetic products worn by the patient . . . would be captured with

the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data.” Id.

Appellants respectfully disagree with the Examiner’s unsupported obviousness allegations. Groh discloses a method of evaluating follicular biopsy specimens in order to count the number of comedones present in the specimen. (Abstract.) Groh’s method includes applying an adhesive to the skin, applying a microscopic slide to the skin, allowing the adhesive to set, and then removing the slide with the adhesive and the skin attached thereto. (Id.) Contrary to the rejection statement’s assertions about Groh, any substances (such as, e.g., at least some cosmetic products) that might interfere with the adhesive’s adherence to the skin, would need to be removed from the skin to ensure that the adhesive would adhere to the skin in a manner sufficient to remove a portion of the skin when the slide is removed. Thus, Groh suggests that cosmetics should be removed from the skin prior to applying the adhesive to the skin. Moreover, because Groh’s process is intended to be used to count comedones, Groh would not provide any suggestion to pick up any material other than a follicular biopsy of the skin. Further, additional material picked up by the slide would only hinder Groh’s intended analysis of the comedones. For at least these reasons, Groh teaches away from the Examiner’s unsupported allegation about capturing cosmetic product on the slide along with the follicular biopsy specimens. Indeed, if the Groh device were used to capture cosmetic product on the slide, there is no reasonable expectation that Groh’s device and process could be used to count comedones in a successful manner, which is the purpose expressly disclosed in Groh. Thus, there is no reasonable expectation that if the device of Groh were to be modified to capture facial cosmetics as alleged, such a modification

would be successful. As outlined above, such a modification to pick up additional material via the slide would only hinder Groh's intended analysis of the comedones.

In the "Response to Arguments" section of the final Office Action, the Examiner alleges that "[t]here is no teaching within Groh of how the skin is treated prior to the biopsy procedure with the application of the adhesive to the skin," and that "the probability of a cosmetic product . . . or soap visible on the skin would result in additional elements retrieved in addition to the comedones." Final Office Action at 15 (emphasis added). Appellants respectfully submit that contrary to the guidance of the M.P.E.P., the Examiner appears to be improperly relying on mere "probabilit[ies]" in an attempt to support the § 103(a) rejection based on Groh.

The M.P.E.P. suggests that when a reference fails to expressly disclose subject matter recited in a claim, what the reference inherently discloses may be relied on. But the M.P.E.P. cautions that "[i]nherency . . . may not be established by probabilities or possibilities." § 2112 (quoting In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)). In particular, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Id. (citing In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993)). Thus, to "rely[] upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Id. (quoting Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Appellants respectfully submit that the Examiner has improperly relied “the probability of a cosmetic product . . . or soap visible on the skin” (emphasis added) and improper hindsight reasoning in order to reject Appellants’ independent claim 4. Groh does not expressly disclose any cosmetic product or soap on the subject’s skin, and it is not necessarily the case that cosmetic product or soap would be present. Further, Groh suggests that cosmetics or soap should be removed from the skin prior to applying the adhesive to the skin by virtue of relying on a level of adherence of the adhesive to the skin that is sufficient to result in removal of a portion of the subject’s skin, yielding a follicular biopsy specimen. As a result, far from necessarily flowing from Groh’s disclosure, Groh’s disclosure more fairly suggests that the subject’s skin should be free of cosmetic product and soap. Thus, the Examiner’s reliance on a “probability” of a presence of cosmetic product or soap on skin is improper and contrary to how a person of ordinary skill in the art would interpret the teachings of Groh’s disclosure.

For at least the above-outlined reasons, Appellants respectfully submit that independent claim 4 is not *prima facie* obvious based on Groh. Therefore, Appellants respectfully submit that the rejection is improper and should be reversed, and thus Appellants respectfully request that the Board reverse the improper rejection of independent claim 4 under § 103(a) based on Groh. Further, claim 6 depends from independent claim 4. Thus, claim 6 should be patentably distinguishable from Groh for at least the same reasons as independent claim 4, and Appellants respectfully request that the Board reverse the § 103(a) rejection of dependent claim 6 based on Groh.

Regarding the rejection of dependent claims 61 and 62 under § 103(a) based on Groh, Appellants respectfully note that claims 61 and 62 depend from independent

claim 48, which has not been rejected under § 103(a) based on Groh alone. Rather, independent claim 48 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Sheng. Final Office Action at 9. The § 103(a) rejection of claim 48 based on Groh and Sheng expressly concedes that Groh does not disclose all of the subject matter recited in independent claim 48 and thus implicitly concedes that Groh alone does not render all of the subject matter recited in independent claim 48 *prima facie* obvious. Id. For at least this reason, Appellants respectfully submit that the rejection of claims 61 and 62 under § 103(a) based on Groh alone is improper and should be reversed. Thus, Appellants respectfully request that the Board reverse the improper rejection of claims 61 and 62 under § 103(a) based on Groh.

D. Rejection of claims 4, 7, 8, and 11 under 35 U.S.C. § 103(a) based on Stess should be reversed because independent claims 4 and 11 are not *prima facie* obvious based on Stess

The Examiner rejected claims 4, 7, 8, and 11 under 35 U.S.C. § 103(a) based on Stess. Final Office Action at 13. Of those rejected claims, claims 4 and 11 are the only independent claims, and Appellants request reversal of the § 103(a) rejection of independent claims 4 and 11 based on Stess because, as explained in more detail below, the Examiner has failed to establish that independent claims 4 and 11 are *prima facie* obvious based on Stess.

1. **Stess fails to disclose or render obvious all of the subject matter recited in independent claim 4, and the Examiner has failed to articulate any rationale in purported support concerning why the differences between Stess and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art**

According to the M.P.E.P., in order to establish a *prima facie* case of obviousness, the record must “include[] findings of fact concerning the state of the art and the teachings of the references” § 2141(II) (relying on KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 U.S.P.Q.2d (BNA) 1385 (2007), and confirming the legal framework established by Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q. (BNA) 459, 467 (1966)). Moreover, “[o]nce the findings of fact are articulated, [the rejection statement] must provide an explanation to support an obviousness rejection under 35 U.S.C. [§] 103.” Id. If it is found that the prior art references fail to disclose all of the subject matter recited in a claim, the rejection statement “must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” § 2141(III).

At least because the Examiner has failed to provide a legally sufficient analysis and explanation required to support a proper claim rejection under § 103(a), Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case obviousness with respect to independent claim 4.

For example, Appellants respectfully submit that Stess fails to disclose or render obvious “scanning . . . with an optical image scanner to obtain scanned image data for an image,” as recited in independent claim 4. The Examiner seems to be equating Stess’s general disclosure of a digital scanner 51 with an “optical image scanner.” Final

Office Action at 13. However, Stess merely discloses using a digital scanner to obtain “digital data” relating to the dimensions of an impression shirt. (Col. 6, lines 10-31.) Yet, there is nothing in Stess providing any express or inherent teaching of the recited “scanning . . . with an optical image scanner to obtain scanned image data for an image.” Stess never mentions or suggests an “optical image” or “scanned image data for an image.” Indeed, Stess’s digital scanner is not described as being an “optical image scanner.” Furthermore, there are many digital scanners that are not optical image scanners (i.e., some scanners use technology devoid of any optical imaging). Moreover, since the purpose of Stess’s disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess’s scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any “image data” for an “image.” For at least these reasons, Stess fails to disclose at least this subject matter recited in independent claim 4.

Thus, Appellants respectfully submit that the Examiner has (1) misinterpreted Stess, (2) failed to make proper findings of fact with respect to independent claim 4 and the prior art, and (3) failed to articulate any rationale in purported support concerning why the differences between Stess’s disclosure and the subject matter recited in independent claim 4 would have been purportedly obvious to a person having ordinary skill in the art. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 4. Thus, Appellants respectfully submit that independent claim 4 is patentably distinguishable from Stess.

Moreover, the Examiner concedes that Stess “does not explicitly teach the application of the transfer member in contact with a cosmetic product applied to an

external body portion.” Final Office Action at 14. The Examiner apparently alleges, however, that modifying Stess’s disclosed custom molded orthopedic impression shirt “to capture facial cosmetics worn by the patient” would have been obvious for reasons similar to those alleged by the Examiner with respect to Groh. In particular, the Examiner alleges that “it would have been obvious . . . to modify the device of Groh to capture facial cosmetics worn by the patient,” allegedly because “Groh is used to detect comedones, which often appear on the face,” and “[s]ince application of cosmetic products worn by the patient . . . would be captured with the comedones when the transfer member is placed in contact with the external portion, and such cosmetic would be part of the scanned image data.” Id.

Appellants respectfully note that although the rejection statement does not indicate that the § 103(a) claim rejection based on Stess alone also relies on Groh, the rejection statement refers to the same unsupported rationale as the rationale supplied in purported support of the rejection of claim 4 based on Groh. See id. at 6, 14. Indeed, the Examiner apparently copied the rationale from the rejection statement relating to the § 103(a) rejection based on Groh. Thus, for at least the reasons outlined above with respect to the § 103(a) claim rejection based on Groh, Appellants respectfully submit that the § 103(a) claim rejection based on Stess is improper. In particular, Groh teaches away from the rejection statement’s unsupported assertion about capturing cosmetic product on the slide along with the follicular biopsy specimens, and there is no reasonable expectation that modifying Stess (or Groh) to capture cosmetic product would be successful.

For at least the above-outlined reasons, Appellants respectfully submit that independent claim 4 is not *prima facie* obvious based on Stess, regardless of whether Stess is viewed individually or in combination with Groh. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 4 under § 103(a) based on Stess. Further, claims 7 and 8 depend from independent claim 4. Therefore, they are patentably distinguishable from Stess for at least the same reasons as independent claim 4, and Appellants respectfully request reversal of the § 103(a) rejection of dependent claims 7 and 8 based on Stess.

2. **Stess fails to disclose or render obvious all of the subject matter recited in independent claim 11, and the Examiner has failed to articulate any rationale in purported support concerning why the differences between Stess and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art**

Appellants respectfully submit that for reasons at least similar to those outlined above with respect to the rejection of independent claim 4 under § 103(a) based on Stess, the rejection of independent claim 11 is improper. For example, independent claim 11 recites, among other things, “scanning . . . with an optical image scanner to obtain scanned image data for an image” As outlined above, Stess fails to render this subject matter recited in independent claim 11 *prima facie* obvious.

Moreover, independent claim 11 also recites placing “moldable material [of a transfer member] in direct contact with the skin of [an] individual to produce, on the moldable material, the surface profile of the skin.” Stess mentions a resin-impregnated, thin, elastic fabric impression shirt 27 (col. 4, lines 12-13), but the impression shirt 27 is not disclosed as being placed in direct contact with skin of an individual. In fact, Stess

describes in detail the necessity of a thermal insulation layer and how to prevent direct contact with the skin. See, e.g., col. 3, lines 29-40, 58-67; col. 4, lines 54-67. Thus, not only does Stess fail to teach placing moldable material in direct contact with skin, as recited in claim 11, but Stess also teaches away from any such contact. Moreover, Stess does not disclose producing, on moldable material, the surface profile of skin, as recited in claim 11.

For at least these reasons, Appellants respectfully submit that independent claim 11 is patentably distinguishable from Stess. Therefore, Appellants respectfully request that the Board reverse the improper § 103(a) rejection of independent claim 11 based on Stess.

E. Rejection of claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh, Kvedar, and Sheng should be reversed because independent claims 25 and 38 are not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

The Examiner rejected claims 25-36 and 38-45 under 35 U.S.C. § 103(a) based on Groh, Kvedar, and Sheng. Final Office Action at 9. Of those rejected claims, claims 25 and 38 are the only independent claims, and Appellants request reversal of the § 103(a) rejection of independent claims 25 and 38 because, as explained in more detail below, the Examiner has failed to establish that independent claims 25 and 38 are *prima facie* obvious based on Groh, Kvedar, and Sheng.

- 1. Independent claim 25 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants' independent claim 25 has been rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng. Although the Examiner concedes that Groh "does not expressly disclose the use of a document scanner to scan the image from the transfer member," the Examiner alleges that "Sheng discloses the use of a flat bed image scanner to scan a document or picture (13) to a digitized format for conveying the image to a computer." Final Office Action at 12. Thereafter, the Examiner alleges that "[i]t would have been obvious . . . to have provided the process for acquiring scanned image data, as disclosed by Groh, wherein the image data is transferred to a second location and analyzed with the process taught by Kvedar et al., to allow remote and repeatable analysis of a condition of the external portion and the flat bed document scanner as taught by Sheng to enable the transfer of the image to a digitized computer format 12." Id.

Appellants respectfully submit that the § 103(a) rejection of independent claim 25 based on rejection statement's hypothetical combination of Groh, Kvedar, and Sheng is improper for a number of reasons and should thus be reversed. First, the Examiner's hypothetical modification to Groh's disclosed method of using image analysis under cross-polarized light to evaluate follicular biopsy slides would defeat its disclosed principle of operation. Groh discloses that using cross-polarized light to view skin samples "is highly desirable because when the planes of polarization are adjusted properly, . . . the comedones will appear as glowing areas against the backdrop of a

darker skin surface.” (Col. 2, ll. 54-64.) Groh thereafter discloses that programmable image analysis hardware and software is used to capture the image and store it as determined by a machine-readable task list written by the evaluating scientist. (Col. 4, ll. 47-54.) Thus, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat image bed scanner disclosed by Sheng would defeat Groh’s principle of operation by preventing a scientist from writing a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability.

Second, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, as disclosed in Groh. One of ordinary skill in the art would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. In addition, a person skilled in the art would not have any reasonable expectation that such a use for a scanner for documents, books, and pictures would be successful. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh’s field to substitute Groh’s follicular-biopsy-slide scanner with Sheng’s flat bed image scanner for documents, books, and pictures.

For at least the above-outlined reasons, Appellants’ independent claim 25 is patentably distinguishable from Groh, Kvedar, and Sheng, regardless of whether those references are viewed individually or as a whole. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 25 under § 103(a) based on the Examiner’s hypothetical combination of those references. Further, claims 26-36 depend from independent claim 25. Therefore, they are

patentably distinguishable from Groh, Kvedar, and Sheng for at least the same reasons as independent claim 25, and Appellants respectfully request reversal of the § 103(a) rejection of dependent claims 26-36 based on Groh, Kvedar, and Sheng.

2. Independent claim 38 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful

Regarding the rejection of Appellants' independent claim 38 under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Sheng, independent claim 38 recites "wherein the image scanner is configured in the form of a scanner for scanning documents." For at least reasons similar to those outlined above with respect to the rejection of independent claim 25 based on Groh, Kvedar, and Sheng, Appellants respectfully submit that independent claim 38 is not *prima facie* obvious based on Groh, Kvedar, and Sheng, regardless of whether those references are viewed individually as a whole. Therefore, Appellants respectfully request that the Board reverse the improper § 103(a) rejection of independent claim 38 based on Groh, Kvedar, and Sheng. Further, claims 39-45 depend from independent claim 38. Therefore, they are patentably distinguishable from those references for at least the same reasons as independent claim 38, and Appellants respectfully request reversal of the § 103(a) rejection of dependent claims 39-45 based on Groh, Kvedar, and Sheng.

F. Rejection of claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh and Kvedar should be reversed because independent claims 37 and 46 are not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

The Examiner rejected claims 37, 46, and 47 under 35 U.S.C. § 103(a) based on Groh and Kvedar. Final Office Action at 6. Of those rejected claims, claims 37 and 46 are the only independent claims, and Appellants request reversal of the § 103(a) rejection of independent claims 37 and 46 because, as explained in more detail below, the Examiner has failed to establish that independent claims 37 and 46 are *prima facie* obvious based on Groh and Kvedar.

1. Groh and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claim 37, and the Examiner has failed to articulate any rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art

The Examiner concedes that Groh does not disclose the “comparing of the displayed image,” as recited in independent claim 37, but the Examiner alleges that Kvedar discloses “the comparison of images for the purpose of assessing the progress of the patient’s treatment (Page 362, Column 2, Paragraph 1.)” Final Office Action at 7. Thereafter, the Examiner further alleges that “it would have been obvious . . . to compare images as taught by Kvedar to monitor the progression of the patient’s treatment and determine appropriate care methods.” Id.

Appellants respectfully submit that the rejection of independent claim 37 based on the Examiner’s hypothetical combination of Groh and Kvedar is improper. The Examiner has misinterpreted Kvedar. Contrary to the Examiner’s allegations, Kvedar

does not disclose comparing images for the purpose of assessing a patient's progress. Rather, the portion of Kvedar to which the Examiner refers in purported support of the allegations, discloses reviewing patient histories and images and rendering opinions thereabout. Nowhere in Kvedar is there any disclosure, however, relating to comparing images for the purpose of assessing a patient's progress. Thus, the hypothetical combination of Groh and Kvedar does not disclose all of the subject matter recited in Appellants' independent claim 37, and the Examiner has failed to explain how these differences between the combined disclosures of Groh and Kvedar and independent claim 37 would purportedly have been obvious to a person having ordinary skill in the art.

For at least this reason, Appellants respectfully submit that the Examiner has (1) misinterpreted Kvedar, (2) failed to make proper findings of fact with respect to independent claim 37 and the prior art, and (3) failed to articulate any rationale in purported support concerning why the differences between the hypothetically combined disclosures of Groh and Kvedar and the subject matter recited in independent claim 37 would have been purportedly obvious to a person having ordinary skill in the art. For at least these above-outlined reasons, the Examiner has failed to establish a *prima case* of obviousness.

Thus, Appellants respectfully submit that independent claim 37 is patentably distinguishable from the Examiner's hypothetical combination of Groh and Kvedar. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 37 under § 103(a) based on those references.

2. Groh and Kvedar fail to disclose or render obvious all of the subject matter recited in independent claim 46, and the Examiner has failed to articulate any rationale in purported support concerning why the differences between those references and the subject matter recited would have been purportedly obvious to a person having ordinary skill in the art

Appellants' respectfully submit that the rejection of independent claim 46 under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar is improper at least because Groh and Kvedar, regardless of whether they are viewed individually or as a whole, fail to disclose or render *prima facie* obvious "[a] process of evaluating a product applied to an external body portion," as recited in independent claim 46. Rather, Groh discloses a method of using image analysis under cross-polarized light to evaluate follicular biopsy slides, and Kvedar discloses sending, from a primary care provider to a dermatologist via the Internet, images of a patient's skin taken by a digital camera. Thus, neither Groh nor Kvedar discloses evaluating a product applied to an external body portion. Further, the Examiner's allegations outlined above with respect to modifying the device of Groh to capture facial cosmetics (Final Office Action at 6) are unsupported and thus improper for at least the reasons outlined above with respect to the § 103(a) rejection of independent claim 4 based on Groh.

Thus, Appellants respectfully submit that the Examiner has (1) misinterpreted Groh and Kvedar, (2) failed to make proper findings of fact with respect to independent claim 46 and the prior art, and (3) failed to articulate any rationale in purported support concerning why the differences between the Examiner's hypothetically combined disclosures of Groh and Kvedar and the subject matter recited in independent claim 46 would have purportedly been obvious to a person having ordinary skill in the art. For at

least these above-outlined reasons, the Examiner has failed to establish a *prima case* of obviousness.

Thus, Appellants respectfully submit that independent claim 46 is patentably distinguishable from the Examiner's hypothetical combination of Groh and Kvedar. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 46 under § 103(a) based on those references. Further, claim 47 depends from independent claim 46. Therefore, claim 47 is patentably distinguishable from Groh and Kvedar for at least the same reasons as independent claim 46, and Appellants respectfully request reversal of the § 103(a) rejection of claim 47 based on Groh and Kvedar.

G. Rejection of claim 48 under 35 U.S.C. § 103(a) based on Groh and Sheng should be reversed because independent claim 48 is not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole

- 1. Independent claim 48 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants respectfully request reversal of the § 103(a) rejection of independent claim 48 based on Groh and Sheng because those references fail to render independent claim 48 *prima facie* obvious. The Examiner concedes that Groh "does not expressly disclose the use of a document scanner to scan the image from the transfer member." Final Office Action at 9. The Examiner alleges, however, that based on Sheng's disclosure of a flat bed image scanner for scanning documents, pictures, and

books, "it would have been obvious . . . to utilize a flat bed image scanner . . . to enable the transfer of an image to a computer." Id.

For at least the reasons outlined above with respect the § 103(a) rejection of independent claim 25 based on Groh, Kvedar, and Sheng, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 48. Contrary to the Examiner's obviousness allegation, substituting the disclosed programmable image analysis hardware and software desired by Groh with the flat bed image scanner disclosed by Sheng would defeat Groh's principle of operation by preventing a scientist from writing a machine-readable task list for the image analysis hardware and software, since Sheng does not disclose such a capability. Moreover, Sheng discloses a flat bed image scanner for scanning documents, books, and pictures (col. 1, ll. 11-13), but does not disclose any scanning of a follicular biopsy slide, as disclosed in Groh. One of ordinary skill in Groh's art relating to analyzing follicular biopsy slides would not have had any reason to use a scanner for documents, books, and pictures in the scanning of a follicular biopsy slide. In addition, a person skilled in the art would not have any reasonable expectation that such a use for a scanner for documents, books, and pictures would be successful. For at least these additional reasons, it would not have been obvious for a skilled artisan in Groh's field to substitute Groh's follicular-biopsy-slide scanner with Sheng's flat bed image scanner for documents, books, and pictures.

For at least the above-outlined reasons, Appellants' independent claim 48 is patentably distinguishable from Groh and Sheng. Therefore, Appellants respectfully request that the Board reverse the improper rejection of independent claim 48 under

§ 103(a) based on the rejection statement's hypothetical combination of Groh and Sheng. Further, claims 61 and 62 depend from independent claim 48. Thus, although claims 61 and 62 were not rejected under 35 U.S.C. § 103(a) based on Groh in combination with Sheng, claims 61 and 62 are patentably distinguishable from Groh and Sheng for at least the same reasons as independent claim 46.

H. **Rejection of claim 59 under 35 U.S.C. § 103(a) based on Groh, Kvedar, and Murad should be reversed because independent claim 59 is not *prima facie* obvious based on those references, regardless of whether they are viewed individually or as a whole**

1. **Independent claim 59 is not *prima facie* obvious because the Examiner's proposed, hypothetical modification to Groh's device would defeat its principle of operation, and further, there is no reasonable expectation that the hypothetical modification would be successful**

Appellants' independent claim 59 was rejected under 35 U.S.C. § 103(a) based on Groh in combination with Kvedar and Murad. The Examiner concedes that Groh fails to disclose "analysis equipment . . . chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin," as recited in independent claim 59. Final Office Action at 8. The Examiner alleges, however, that "it would have been obvious . . . to modify the system of Groh/Kvedar to include the use of a corneometer as taught by Murad, as a method of detecting the health of the skin in relationship to treatment methods." Id.

Appellants respectfully submit that the § 103(a) claim rejection is improper and should be reversed. Murad discloses the use of a corneometer for measuring skin hydration. (Col. 28, ll. 53-57.) In contrast, Groh is directed to determining the number

of comedones present in a follicular biopsy slide. There is no reason an artisan in Groh's field would have looked to Murad to use a corneometer to measure skin hydration at least because it is not used for measuring the number of comedones present in a follicular biopsy slide. Thus, using a corneometer to measure the number of comedones would defeat the principle of operation of Groh's device, which relies on the use of adhesive and slides rather than a corneometer. Further, because a corneometer is not used for measuring the number of comedones present in a follicular biopsy slide, an artisan in Groh's field would have no reasonable expectation that adding a corneometer to Groh's device would be successful in improving Groh's device for measuring the number of comedones.

For at least these reasons, Appellants respectfully submit that independent claim 59 is not *prima facie* obvious based on Groh, Kvedar, and Murad, regardless of whether those references are viewed individually or as a whole. Therefore, Appellants respectfully request that the Board reverse the improper § 103(a) rejection of independent claim 59 based Groh, Kvedar, and Murad.

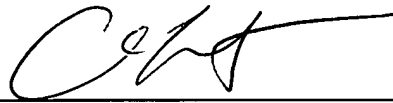
I. Conclusion

For at least the reasons given above, pending claims 4-20, 24-48, 59, 61, and 62 are in compliance with 35 U.S.C. § 112, first and second paragraphs, and are patentably distinguishable from Groh, Stess, Kvedar, Sheng, and Murad, regardless of whether those references are viewed individually or as a whole. Appellants therefore respectfully request that the Board reverse all of the claim rejections under 35 U.S.C. §§ 112, first and second paragraphs, and 103(a), so that all of pending claims 4-20, 24-48, 59, 61, and 62 may be allowed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, please charge such fees to our Deposit Account 06-0916.

Respectfully submitted,
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 8, 2009

By: 
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VIII. Claims Appendix

Claims 1-3 (Canceled).

4. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product.

Claim 5 (Withdrawn).

6. The process of claim 4, wherein the external portion includes skin and wherein the cosmetic product is foundation makeup.

7. The process of claim 6, wherein the transfer member is formed of fabric.

8. The process of claim 7, wherein the transfer member is an article of clothing.

Claims 9 and 10 (Withdrawn).

11. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is a moldable material, and wherein the process includes placing the moldable material in direct contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin.

Claims 12-20 (Withdrawn)

Claims 21-23 (Canceled).

Claim 24 (Withdrawn).

25. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the image scanner is associated with a first computer located at a first location, and wherein the process further comprises transferring the scanned image data from the first computer to a second computer located at a second location remote from the first location, and

wherein the image scanner is configured in the form of a scanner for scanning documents.

26. The process of claim 25, wherein the transferring includes transmitting the scanned image data via the Internet.

27. The process of claim 25, further comprising storing the scanned image data on a data storage medium, wherein the transferring includes shipping the data storage medium to the second location.

28. The process of claim 25, further comprising transferring questionnaire answers from the first location to the second location, at least some of the questionnaire answers being related to at least one of a condition of the external portion and the product applied to the external body portion.

29. The process of claim 25, further comprising sending to the second location at least one of billing information and payment information.

30. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

acquiring scanned image data according to the process of claim 25;
displaying an image corresponding to the scanned image data; and
viewing the displayed image to analyze said at least one characteristic.

31. The process of claim 30, wherein the image is displayed at the second location.

32. The process of claim 30, further comprising sending the scanned image data to a plurality of locations so that the at least one characteristic may be analyzed numerous times.

33. The process of claim 30, further comprising monitoring status of the external portion during treatment of the external portion.

34. The process of claim 33, further comprising providing a recommendation for a treatment of the external portion based on the monitored status.

35. The process of claim 33, further comprising providing the individual with information regarding the effectiveness of the treatment.

36. The process of claim 33, wherein the monitoring includes repeating at least the acquiring.

37. A process of analyzing at least one characteristic of an external body portion of an individual and/or at least one product applied to the external body portion, the process comprising:

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion;

displaying an image corresponding to the scanned image data;

viewing the displayed image to analyze said at least one characteristic; and

comparing the displayed image to at least one image formed from image data stored in an image database.

38. A process for recommending treatment for an external body portion, the process comprising:

- analyzing at least one characteristic of an external body portion wherein the analyzing comprises
 - acquiring scanned image data, wherein the acquiring comprises
 - placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,
 - wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,
 - wherein the transfer image is not a fingerprint or fingerprints, and
 - wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;
 - scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of
 - the external body portion, and/or
 - at least one product applied to the external body portion;
 - displaying an image corresponding to the scanned image data; and
 - viewing the displayed image to analyze said at least one characteristic;

determining a recommendation of at least one treatment for the external portion;
and
providing the treatment recommendation so that the external portion of the individual may be treated according to the recommendation,
wherein the image scanner is configured in the form of a scanner for scanning documents.

39. The process of claim 38, wherein the treatment recommendation is a recommendation regarding use of at least one of a cosmetic product and a dermatological product.

40. The process of claim 39, wherein said at least one of the cosmetic product and the dermatological product is one of a makeup product, a care product, a hair product, a skin product, and a sun exposure product.

41. The process of claim 39, wherein the treatment recommendation is a recommendation regarding application of said at least one of the cosmetic product and the dermatological product to the external portion.

42. The process of claim 38, further comprising providing product ordering information along with the treatment recommendation.

43. The process of claim 38, wherein the providing of the treatment recommendation includes providing the treatment recommendation to at least one of the individual and a treatment provider.

44. The process of claim 43, wherein the providing of the treatment recommendation includes transmitting said recommendation to said at least one of the individual and the treatment provider via the Internet.

45. The process of claim 38, wherein a computer at least partially performs the determining of the treatment recommendation, the computer being located at a location remote from that of the image scanner.

46. A process of evaluating a product applied to an external body portion, the process comprising:

analyzing at least one characteristic of a product applied to an external body portion wherein the analyzing comprises

acquiring scanned image data, wherein the acquiring comprises

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth, and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion;

displaying an image formed from the scanned image data; and

viewing the displayed image to analyze said at least one characteristic.

47. The process of claim 46, wherein the transfer member is placed in contact with an external body portion including a cosmetic product applied thereto, and wherein the scanned image data is representative of at least one characteristic of the cosmetic product.

48. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion; and

collecting information relating to the transfer image of the transfer member to form a database for use in at least one of diagnoses, treatment recommendation determinations, product evaluations, and product formulations,

wherein the image scanner is configured in the form of a scanner for scanning documents.

Claims 49-58 (Canceled).

59. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth;

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of the external body portion, and/or at least one product applied to the external body portion; and analyzing at least one of the external body portion and the transfer member with analysis equipment, wherein the analysis equipment is chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of the skin.

Claim 60 (Canceled).

61. The process of claim 48, further comprising providing a grade indicative of at least one of the condition of the external portion and performance of the product.

62. The process of claim 61, further comprising storing information relating to the grade in a database.

Claim 63 (Canceled).

IX. Evidence Appendix

None

X. Related Proceedings Appendix

In U.S. Application No. 09/725,049 (attorney docket No. 05725.0784-00000), which is now abandoned, an Appeal Brief was filed on August 15, 2005, and the Examiner subsequently re-opened prosecution prior to any decision by the Board. The Appeal Brief filed in U.S. Application No. 09/725,049 may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, and a copy of that Appeal Brief has been submitted herewith.